Supreme Court, U.S.
FILED

01 186 JUL 30 2001

OFFICE OF THE CLERK

No. 01-

IN THE
Supreme Court of the United States

NATIONAL GEOGRAPHIC SOCIETY,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.,
AND MINDSCAPE, INC.,

Petitioners,

v.

JERRY GREENBERG AND IDAZ GREENBERG,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

PETITION FOR WRIT OF CERTIORARI

TERRENCE B. ADAMSON
ANGELO M. GRIMA
KAREN K. SCHWARTZ
NATIONAL GEOGRAPHIC SOCIETY
1145 Seventeenth Street, N.W.
Washington, D.C. 20036

KENNETH W. STARR
Counsel of Record
CHRISTOPHER LANDAU
KIRKLAND & ELLIS
655 Fifteenth Street, N.W.
Washington, D.C. 20005
(202) 879-5000

ROBERT G. SUGARMAN
NAOMI JANE GRAY
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153

July 30, 2001

74 pp

QUESTIONS PRESENTED

1. Whether a publisher's exact, image-based reproduction of a collective work in CD-ROM format infringes the copyrights of freelance contributors to that collective work.

2. Whether an applicant for a copyright registration perpetrates a "fraud" on the Copyright Office when the applicant discloses "the material . . . in which copyright is claimed," as the Copyright Office requires, and the Copyright Office itself insists that the applicant provided full disclosure.

PARTIES TO THE PROCEEDING AND CORPORATE DISCLOSURE STATEMENT

Petitioners National Geographic Society, National Geographic Enterprises, Inc., and Mindscape, Inc., were defendants/appellees below. Petitioner National Geographic Society is a not-for-profit membership organization. Petitioner National Geographic Enterprises, Inc. (now named National Geographic Holdings, Inc.) is a wholly owned subsidiary of NGV, Inc., which in turn is a wholly owned taxable subsidiary of petitioner National Geographic Society. Petitioner Mindscape, Inc. (now incorporated under the name Mindscape LLC) is wholly owned by Mindscape Holdings LLC, and no publicly held company owns 10% or more of its stock.

Respondents Jerry and Idaz Greenberg were plaintiffs/appellants below.

TABLE OF CONTENTS

Page

QUESTIONS PRESENTED i

PARTIES TO THE PROCEEDING AND CORPORATE DISCLOSURE STATEMENT ... ii

TABLE OF AUTHORITIES iv

INTRODUCTION 1

OPINIONS BELOW 3

JURISDICTION 3

PERTINENT STATUTORY PROVISION 3

STATEMENT OF THE CASE 4

REASONS FOR GRANTING THE WRIT 9

I. THE ELEVENTH CIRCUIT ERRED, AND CREATED A CONFLICT WITH THIS COURT'S SUBSEQUENT DECISION IN *TASINI*, BY HOLDING THAT A PUBLISHER'S EXACT, IMAGE-BASED REPRODUCTION OF A COLLECTIVE WORK IN CD-ROM FORMAT INFRINGES THE COPYRIGHTS OF FREELANCE CONTRIBUTORS. 9

II. THE ELEVENTH CIRCUIT ERRED BY HOLDING THAT AN APPLICANT FOR A COPYRIGHT REGISTRATION PERPETRATES A "FRAUD" ON THE COPYRIGHT OFFICE WHEN THE APPLICANT DISCLOSES ALL THE INFORMATION THAT THE COPYRIGHT OFFICE REQUIRES. 18

CONCLUSION 22

TABLE OF AUTHORITIES

Page

Cases

Fogerty v. Fantasy, Inc.,
510 U.S. 517 (1994) 8

New York Times Co. v. Tasini,
121 S. Ct. 2381 (2001) ..... *passim*

Shannon v. United States,
512 U.S. 573 (1994) 14

Constitutions, Statutes, and Rules

17 U.S.C. § 201(c) ..... *passim*

28 U.S.C. § 1254(1) 3

S. Ct. R. 10(a) 18

U.S. Const. art. II, § 8, cl. 8 18

Other Authorities

37 C.J.S. Fraud (1997) 19

H.R. Rep. No. 94-1476 (1976) 7, 13, 15

INTRODUCTION

This case is about the preservation of collective works (including magazines, newspapers, and encyclopedias) for the education and entertainment of future generations. The Copyright Act grants freelance authors the copyrights in their individual contributions to collective works, but grants the publishers of such works a privilege to reproduce such contributions "as part of [1] that particular collective work, [2] any revision of that collective work, and [3] any later collective work in the same series." 17 U.S.C. § 201(c). As this Court recently recognized, that provision strikes a fundamental balance between the rights of authors and publishers: a publisher may not exploit an individual freelance contribution outside the context of the collective work, but may reproduce the collective work itself in a new medium. *New York Times Co. v. Tasini*, 121 S. Ct. 2381, 2391-92 (2001).

In this case (decided before *Tasini*), however, the Eleventh Circuit effectively wrote this privilege out of the United States Code. At issue here is "The Complete National Geographic" (CNG), a thirty-disc CD-ROM set reproducing each monthly issue of *National Geographic* magazine from 1888 through 1996. Every page of every issue remains as it was in the original print version, including *all* page arrangements, stories, photographs, graphics, advertising, and attributions. A user thus encounters all freelance contributions (in the words of the *Tasini* Court) in "the context provided . . . by the original periodical editions." 121 S. Ct. at 2390-91. The conversion to CD-ROM format "represent[s] a mere conversion of intact periodicals (or revisions of periodicals) from one medium to another." *Id.* at 2392.

The Eleventh Circuit nonetheless held that Section 201(c) did not apply because the CNG is a "new collective work," and, in the court's view, the creation of a new collective work necessarily defeats the statutory reproduction privilege. App. 9a-13a. That is simply incorrect. Section 201(c) allows a publisher to reproduce a freelance contribution in the "particular collective work" to which the author contributed, or "any revision of that collective work," regardless of whether

the publisher thereby creates a "new" and larger collective work. That is precisely why, as the *Tasini* Court emphasized, Section 201(c) authorizes the reproduction of a paperbound collective work in the different media of microfilm or microfiche, even though "the microfilm roll contains multiple editions." 121 S. Ct. at 2391. As long as each individual contribution remains in its "original context," the publisher has not infringed the author's copyright. *Id.*

It is hard to overstate the practical consequences of the decision below. Rather than preserving a balance between the author's copyright in an individual contribution and a publisher's copyright in the collective work as a whole, the decision gives freelancers the power to stop publishers from creating electronic archives of their collective works. As a practical matter, no publisher could create such an archive if exact, image-based reproductions of past issues were to violate freelancers' copyrights. Thus, if allowed to stand, the decision below would prevent publishers, including National Geographic, from creating and preserving electronic archives for the benefit of history and unknown generations of individuals, students, and scholars. That result turns Section 201(c)—and *Tasini*—upside down.

And the Eleventh Circuit was not content merely to strip National Geographic of its statutory reproduction privilege. In addition, the court accused the Society of having "perpetrated a fraud on the Copyright Office," by having "failed to indicate" the existence of the CD-ROM's computer program when registering the CNG. That accusation is manifestly incorrect, because the Copyright Office requires an applicant in a multimedia work like the CNG to set forth "all the new copyrightable authorship *that is the basis of the present registration*," and the Society never claimed authorship of the computer program. That may explain why this issue was never briefed or argued until the Eleventh Circuit *sua sponte* launched the accusation in its opinion. What remains unexplained (and inexplicable), however, is the Eleventh

Circuit's refusal to correct this error, even after it was brought to the court's attention on rehearing, and even after *the Copyright Office itself* explained that the court had misconstrued its disclosure requirements. This Court should not allow the lower courts thus to besmirch a litigant's reputation, and to disregard a federal agency's interpretation of its own rules of practice and procedure.

OPINIONS BELOW

The Eleventh Circuit's "corrected" opinion is reported at 244 F.3d 1267 and reprinted in the Appendix ("App.") at 1a-21a. That opinion reflects a number of changes made by the Eleventh Circuit while the petition for rehearing was pending. For this Court's convenience, the passages of the original opinion omitted from the "corrected" opinion are indicated with strikeout text, App. 16a, and the passage added to the "corrected" opinion is indicated with highlighted text, *see id.* The unreported order denying the petition for rehearing and rehearing *en banc* is reprinted at App. 22a-23a. The district court's unpublished order and opinion granting petitioners' motion for summary judgment is reprinted at App. 37a-44a.

JURISDICTION

The Eleventh Circuit entered judgment on March 22, 2001. Petitioners timely filed a petition for rehearing and rehearing *en banc*, which was denied on June 8, 2001. App. 22a-23a. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

PERTINENT STATUTORY PROVISION

Section 201(c) of the Copyright Act provides:

> Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege

> of reproducing and distributing the contribution as part of [1] that particular collective work, [2] any revision of that collective work, and [3] any later collective work in the same series.

17 U.S.C. § 201(c).

STATEMENT OF THE CASE

Petitioner National Geographic Society is the world's largest nonprofit scientific and educational organization, with approximately ten million members worldwide. The Society engages in promoting and funding scientific research, exploration, and grants for geography education, and has given more than 7,000 grants for scientific research. Since its founding in 1888, the Society has published a monthly official journal, *National Geographic* magazine.

For many years, the Society has reproduced back issues of the magazine in bound volumes, microfiche, and microfilm. With the advent of CD-ROM technology in recent years, the Society in 1997 produced "The Complete National Geographic" (CNG), a thirty-disc CD-ROM set containing each monthly issue of the magazine for the 108 years from 1888 through 1996. App. 3a. The issues appear chronologically, from the earliest at the beginning of the first disc to the latest at the end of the thirtieth disc. There are no changes to the content, format, or appearance of any issue reproduced in the CD-ROM set. *Id.* at 4a. Every page of every issue remains as it was in the original print version, including all page arrangements, articles, photographs, graphics, advertising, and attributions. *Id.*

The CNG, like any other CD-ROM product, also contains a computer program. *Id.* at 4a-5a. That program not only compresses and decompresses the images, but also allows the user to search an electronic version of *National Geographic*'s traditional subject, title, and author-based index. *Id.* An article, once retrieved through the search function, appears just as it did in the original paperbound magazine, with all of the

surrounding materials from the original magazine. The program does not provide a means for the user to separate the photographs from the text or otherwise to edit the pages in any way. *Id.* at 4a.

Whenever a CNG disc is inserted into a CD-ROM drive, it automatically launches an introductory sequence of ten past covers of the magazine that fade into one another. *Id.* at 3a-4a. This "moving covers" sequence, which is accompanied by music and sound effects, lasts for 25 seconds. *Id.* Following the initial installation, a user can stop the moving covers sequence at any time with the click of a button.

After placing the CNG on the market, the Society obtained a copyright registration for the product from the United States Copyright Office. Under settled law and practice, that Office considers a CD-ROM like the CNG to be a "multimedia work." As relevant here, an applicant for a copyright in such a work must "[g]ive a brief, general statement of the material that has been added to this work *and in which copyright is claimed.*" *Id.* at 12a (emphasis added). Accordingly, the Society claimed a copyright in the "[b]rief introductory audiovisual montage." *Id.* The Copyright Office registered the CNG copyright effective July 14, 1998. *Id.* at 18a.

Respondent Jerry Greenberg is a freelance photographer whose pictures were published in the January 1962, February 1968, May 1971, and July 1990 issues of *National Geographic* magazine. *Id.* at 2a-3a. Greenberg's photograph of a diver appeared on the cover of the January 1962 issue, and that cover was one of the ten "moving covers" in the CNG's introductory sequence. *Id.* at 3a-4a.

Greenberg and his wife, respondent Idaz Greenberg, filed this lawsuit in December 1997, alleging that the Society's reproduction of his photographs in the CNG infringed their copyrights. (Respondents did not dispute that the Society was entitled to publish Greenberg's photographs in *National Geographic* magazine in the first instance.) The lawsuit named

as defendants not only the Society, but also its subsidiary, petitioner National Geographic Enterprises, Inc., which developed the CNG product, and petitioner Mindscape, Inc., which distributed the product. *Id.* at 6a. Respondents alleged that the liability of these latter defendants was "at least vicarious." *Id.* at 7a n.6.

Petitioners moved for summary judgment on the ground that Section 201(c) of the Copyright Act authorizes the publisher of a collective work like *National Geographic* magazine to reproduce that collective work in a new medium like CD-ROM. The district court (Lenard, J., S.D. Fla.) granted the motion, because "th[e] original selection and arrangement" of the print magazine "is preserved in The Complete National Geographic." *Id.* at 42a. The court specifically rejected respondents' argument that "the image display and Society logo at the beginning of each disc, the credit display at the end of each disc, and Society's selection of one edition of the many editions of the magazine, render The Complete National Geographic more than trivially different from [the print] magazines." *Id.* at 42a-43a. The court did not reach petitioners' separate argument that the use of the January 1962 cover in the "moving covers" sequence was either *de minimis* or fair use. *See id.* at 43a n.*.

The Eleventh Circuit reversed. The court began its analysis by noting that Section 201(c) grants publishers "only a privilege, not a right," and asserting that the privilege must be "narrowly constru[ed]" when balanced against the author's rights. *Id.* at 9a. The court then held that Section 201(c) does not allow petitioners to reproduce back issues of *National Geographic* magazine in the CNG, because the CNG itself is a "new" collective work. *Id.* at 9a-13a. The court made no effort to tie that holding to the language of the statute, which nowhere states that the privilege does not apply to "new" collective works. Instead, the court relied entirely on a passage in the legislative history that "*the publisher could not* revise the contribution itself or *include it in* a new anthology or *an*

entirely different magazine or *other collective work*." *Id.* at 10a (quoting H.R. Rep. No. 94-1476, at 122-23 (1976)) (emphasis added by the court). According to the court, "in creating a new work the Society forfeited any privilege that it might have enjoyed" under Section 201(c). App. 12a-13a (emphasis and footnote omitted). The court separately held that the use of the January 1962 cover in the "moving covers" sequence was neither *de minimis* nor fair use, and thus additionally infringed respondents' copyright in the cover photograph. *Id.* at 13a-16a.

The Eleventh Circuit buttressed its conclusion that CNG was a "new" collective work by noting that the Society had "registered its claim of copyright in the CNG" with the Copyright Office. *Id.* at 11a. The court then focused on the Society's registration application, and especially on the subpart requesting "a brief, general statement of the material that has been added to this work *and in which copyright is claimed*." *Id.* at 12a (emphasis added). As the court noted, the Society responded to that request by stating "'Brief introductory audiovisual montage.'" *Id.* The court then faulted the Society for having "failed to indicate the . . . critical . . . element of the new work, the [computer] Program," *id.* at 12a n.13—*even though the Society never claimed a copyright in that program.* Indeed, the court accused the Society of thereby "perpetrat[ing] a fraud on the Copyright Office." *Id.* The court attached the Society's copyright registration application as an appendix to its published opinion. *Id.* at 18a-19a.

The court concluded by ordering the entry of judgment in respondents' favor. *Id.* at 16a. In addition, the court declared respondents to be the "prevailing part[ies]" on appeal, and "therefore . . . entitled to an award of costs and attorneys fees." *Id.*

Petitioners then filed a petition for rehearing and rehearing *en banc*, noting among other things that this Court was currently considering the correct interpretation of Section 201(c) in *Tasini*. The petition also noted that the court's

accusation of "fraud on the Copyright Office" was baseless, because the computer program was not "material . . . *in which copyright is claimed*" by the Society. *Id.* at 12a (emphasis added). Finally, the petition noted that the reversal of summary judgment in petitioners' favor did not automatically entitle respondents to judgment in their favor, and that in any event even "prevailing parties" in copyright cases are not automatically entitled to attorneys' fees under *Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994).[1]

Several weeks after the petition was filed, the Eleventh Circuit *sua sponte* issued a "corrected" opinion (backdated to the date of the original opinion) deleting the direction to enter judgment and award attorneys' fees in respondents' favor. App. 16a. The court, however, did not dispose of the pending petition for rehearing and rehearing *en banc*.

Petitioners promptly filed a letter amending the pending petition by withdrawing those portions rendered moot by the subsequent "corrected" opinion. Petitioners also attached a letter they had received from the Copyright Office disputing the Eleventh Circuit's conclusion that National Geographic had committed "fraud" in its CNG registration application. Respondents moved to strike petitioners' letter and the attached letter from the Copyright Office. Even before petitioners' time to respond to that motion had expired, the court granted the motion. App. 36a.

On June 8, 2001, while *Tasini* remained pending in this Court, the Eleventh Circuit denied the petition for rehearing and rehearing *en banc*. App. 22a-23a. This petition follows.

---

[1] A number of publishers, including the Magazine Publishers of America, Inc., the Newspaper Association of America, Inc., Gannett Co., Inc., Hachette Filipacchi Magazines, Inc., The New York Times Company, Time Inc., Times Mirror Co., and Tribune Company, timely moved for leave to file an *amicus* brief in support of the petition for rehearing and rehearing *en banc*. The court, however, denied the motion without explanation. App. 24a.

REASONS FOR GRANTING THE WRIT

I. THE ELEVENTH CIRCUIT ERRED, AND CREATED A CONFLICT WITH THIS COURT'S SUBSEQUENT DECISION IN *TASINI*, BY HOLDING THAT A PUBLISHER'S EXACT, IMAGE-BASED REPRODUCTION OF A COLLECTIVE WORK IN CD-ROM FORMAT INFRINGES THE COPYRIGHTS OF FREELANCE CONTRIBUTORS.

This is a straightforward case of statutory interpretation. The Copyright Act grants publishers of collective works a privilege to reproduce freelance contributions as part of the "particular collective work" to which the freelancers contributed, 17 U.S.C. § 201(c), and that is just what National Geographic has done here. The CNG provides an exact, image-based reproduction of each issue of *National Geographic* magazine in CD-ROM format, so that (as the Eleventh Circuit acknowledged) "[w]hat the user of the CNG sees on his computer screen . . . is a reproduction of each page of the Magazine that differs from the original only in the size and resolution of the photographs and text." App. 4a. Because "[e]very cover, article, advertisement, and photograph appears as it did in the original paper copy of the Magazine," *id.*, National Geographic has simply reproduced freelance contributions in a new medium as part of the "particular collective work" to which the freelancers contributed—or, at least, as part of "any revision of that collective work." 17 U.S.C. § 201(c). That is the beginning and the end of this case.

This Court's opinion in *Tasini* confirms this straightforward analysis. At issue in *Tasini* was the reproduction of individual freelance contributions in three electronic databases: (1) LEXIS/NEXIS, (2) the New York Times OnDisc (NTYO), and (3) General Periodicals OnDisc (GPO). 121 S. Ct. at 2385-86. The Court held that such reproduction fell outside the scope of Section 201(c) because in each database "each article is presented to, and retrievable by, the user in isolation, clear of the context the original print publication presented." *Id.* at

2384. With respect to LEXIS/NEXIS and NYTO, both of which store individual articles from collective works in text-only format, "an article appears to a user without the graphics, formatting, or other articles with which the article was initially published." *Id.* at 2391. And with respect to GPO, which stores individual articles from collective works in image-based format, "the article appears with the other materials published on the same page or pages, but without any material published on other pages of the original periodical." *Id.*

Tasini confirms, however, that with respect to a product like the CNG, which includes an exact, image-based reproduction of *every page* of a particular collective work, the Section 201(c) privilege applies. In this situation, each freelance contribution is "presented to, and perceptible by, the user" of the product in its "original context" as "part of the collective work to which the author contributed." 121 S. Ct. at 2390-92. Indeed, the *Tasini* Court went out of its way to note that the reproduction of a collective work in microfilm or microfiche *does* qualify for the privilege. As the Court explained, "articles appear on the microforms, writ very small, in precisely the position in which the articles appeared in the newspaper." *Id.* at 2391. Although "the microfilm roll contains multiple editions, and the microfilm user can adjust the machine lens to focus only on [an] Article, to the exclusion of surrounding material," the dispositive fact remains that the user "encounters the Article in context." *Id.* In this critical regard, the CNG is indistinguishable from microfilm or microfiche.

Indeed, the *Tasini* Court specifically reaffirmed the bedrock principle that the Copyright Act is media-neutral, and "the transfer of a work between media does not alter the character of that work for copyright purposes." *Id.* at 2392 (internal quotation and brackets omitted). Thus, a publisher is entitled to reproduce collective works in new media, as long as it reproduces "intact periodicals," not "individual articles." *Id.* That is why the "crucial fact" in *Tasini* was that "the Databases . . . store and retrieve articles *separately* within a vast domain

of diverse texts," rather than leaving the articles within the context of the particular collective works to which the authors contributed. *Id.* at 2393 (emphasis added). The privilege turns on the preservation of the integrity of the original collective work, not the technology of the medium of reproduction.

The Eleventh Circuit, however, applied an entirely different—and erroneous—analysis. Rather than focusing on whether the CNG presents freelance contributions to users in the "original context" of "the collective work to which the author contributed," *Tasini*, 121 S. Ct. at 2390-92, the court focused instead on whether the CNG itself could be characterized as a "new" collective work, App. 9a-13a. Thus, while acknowledging that "[e]very cover, article, advertisement, and photograph appears as it did in the original paper copy of the Magazine," *id.* at 4a, the court concluded that Section 201(c) did not apply because the CNG itself was a "new" collective work. According to the Eleventh Circuit, the crucial fact here is that the CNG includes not only reproductions of past issues of *National Geographic* magazine, but also an independently copyrightable introductory sequence and computer program. *Id.* at 9a-10a. The addition of these elements of originality, the court asserted, rendered the CNG itself a "new" collective work outside the scope of Section 201(c). *Id.* at 9a-13a. Indeed, the court attempted to distinguish the CNG from microfilm and microfiche by asserting that the computer programs necessary to run a CD-ROM "are themselves the subject matter of copyright, and may constitute original works of authorship." *Id.* at 11a n.12.

The Eleventh Circuit's focus on whether the CNG is a "new" collective work with independently copyrightable features is flatly inconsistent with *Tasini*. The *Tasini* Court, as noted above, framed the inquiry under Section 201(c) on how "the Articles [are] presented to, and perceptible by, the *user* of the Databases." 121 S. Ct. at 2390 (emphasis added); *see also id.* at 2391 n.9 ("This case . . . is about what is presented to the general public in the Databases."). As long as the user

perceives individual freelance contributions as a part of the particular collective work to which the freelancers contributed, it is immaterial whether the publisher has created a "new" work with independently copyrightable features. As the Eleventh Circuit itself acknowledged, a user typically does not know or care about the existence of an independently copyrightable computer program. *See* App. 12a n.13.

Indeed, if the creation of a "new" collective work with independently copyrightable elements were legally dispositive, this Court's analysis in *Tasini* was all wrong and gratuitous. All three databases at issue in *Tasini* (LEXIS/NEXIS, NYTO, and GPO) include computer programs that, like the CNG's computer program, are independently copyrightable. 121 S. Ct. at 2385-86. Each of these databases, thus, could be characterized as a "new" collective work under the Eleventh Circuit's analysis. But the *Tasini* Court never suggested that this point was dispositive. To the contrary, the Court gave this point *no weight whatsoever* in its legal analysis. Rather, as noted above, the *Tasini* Court focused on the entirely different question whether the databases presented individual freelance contributions to the user in "isolation," or instead in "the context the original print publication presented." *Id.* at 2384; *see also id.* ("The publishers are not sheltered by § 201(c), we conclude, *because the databases reproduce and distribute articles standing alone and not in context.*") (emphasis added).

The Eleventh Circuit's focus on the existence of independently copyrightable elements in the CNG (rather than the perceptions of the end user) also violates the bedrock principle of media-neutrality specifically reaffirmed in *Tasini*. The reproduction of a collective work in new media will almost invariably entail the addition of some independently copyrightable element, such as a computer program. Indeed, the very advantages of new media (including, but not limited to, CD-ROM) often consist of independently copyrightable features. Thus, one of the reasons that CD-ROM is such a powerful medium is that its copyrightable computer program

compresses images (allowing the reproduction of vast quantities of information in a limited space), and performs an electronic search function. If the presence of such a program were sufficient to defeat the privilege, then Section 201(c) would *never* permit the reproduction of collective works in CD-ROM or other electronic media. But a "particular collective work" does not cease to be a "particular collective work" just because it is reproduced in a new medium that includes independently copyrightable elements. The Copyright Act is not a Luddite law, and does not prevent publishers from using technological advances to reproduce their collective works in new media.

Indeed, the Eleventh Circuit's analysis would prevent a publisher like National Geographic from reproducing a collective work even in "old" media (such as microfilm and microfiche) because these media too include independently copyrightable elements, such as an introductory page and a subject, title, and author-based index. As noted above, however, the *Tasini* Court specifically recognized that Section 201(c) allows publishers to reproduce their collective works in these media. As long as individual freelance contributions are presented to the user in the context of the original collective work, the addition of intellectual property in any particular medium of reproduction is immaterial.

At bottom, the Eleventh Circuit's analysis ignores the fundamental balance struck by Section 201(c) and reaffirmed in *Tasini*. That provision "accommodate[s]" the author's copyright in an *individual* work and the publisher's copyright in the *collective* work. 121 S. Ct. at 2389; *see also* H.R. Rep. No. 94-1476, at 122-23 (1976) (Section 201(c) "represents a fair balancing of equities" between authors and publishers). Indeed, the publishers' privilege to reproduce its collective work is the "essential counterpart" to the authors' copyright in their individual contributions. *Id.* The Eleventh Circuit's analysis, however, is based on the premise that the publishers' privilege is to be "narrowly constru[ed]" as against "the

constitutionally-secured rights of the author/contributor," App. 9a—a premise not only absent from *Tasini*, but affirmatively inconsistent with the fundamental balance reaffirmed in that decision. By holding that a publisher violates a freelancer's copyright by reproducing an entire *collective* work in any format that includes new elements of originality, the Eleventh Circuit missed the whole point of the statute.

The Eleventh Circuit's analysis and holding are not only inconsistent with *Tasini*, but wholly unrooted in the statutory text. As noted above, the statute specifically authorizes publishers to reproduce freelance contributions as part of the "particular collective work" to which the freelancer contributed, or "any revision of that collective work." 17 U.S.C. § 201(c). The statute nowhere says that this privilege does not apply with respect to reproductions that include independently copyrightable elements. The Eleventh Circuit did not suggest otherwise; to the contrary, the court based its analysis and holding entirely on a passage in the legislative history. (Indeed, the court attached the legislative history as an appendix to its opinion, App. 20a-21a.)

As an initial matter, the Eleventh Circuit's approach to statutory interpretation is itself erroneous, because legislative history is a tool for resolving statutory ambiguity, not a substitute for statutory text. *See, e.g., Shannon v. United States*, 512 U.S. 573, 583-84 (1994) ("[C]ourts have no authority to enforce a principle gleaned solely from legislative history that has no statutory reference point.") (internal quotation and brackets omitted). And, even more to the point, the cited passage from the legislative history does not support the Eleventh Circuit's conclusion.

The court relied on the following passage from the legislative history:

> The basic presumption of section 201(c) is fully consistent with present law and practice, and

> represents a fair balancing of equities. At the same time, the last clause of the subsection, under which the privilege of republishing the contribution under certain limited circumstances would be presumed, is an essential counterpart of the basic presumption. Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; *the publisher could not* revise the contribution itself or *include it in* a new anthology or *an* entirely different magazine or *other collective work.*

App. 10a (quoting H.R. Rep. No. 94-1476, at 122-23 (1976)) (emphasis added by the court).

According to the Eleventh Circuit, these italicized words from the legislative history mean that the publisher of an "other collective work" (*i.e.*, a "new" collective work) necessarily loses the privilege. That is simply not true. To the contrary, the passage underscores the importance of the publisher's privilege (the "essential counterpart" to the author's copyright), and provides two examples of what publishers can and cannot do within the scope of that privilege. According to the passage, Section 201(c) allows a publisher to (1) "reprint a contribution from one issue in a later issue of its magazine," and (2) "reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it," but does not allow the publisher to (1) "revise the contribution itself," or (2) "include it in a new anthology or an entirely different magazine or other collective work."

The Eleventh Circuit seized on the last three words of this passage ("other collective work") to conclude that the statute does not allow a publisher to reproduce a freelance contribution in a new (and independently copyrightable) collective work, even where (as here) that collective work includes an exact image-based reproduction of the original

collective work. But that is not what the passage says. To the contrary, both of the examples of what a publisher *can* do entail the creation of new (and independently copyrightable) collective works: the publication of "a later issue of its magazine," and the publication of a new edition of an encyclopedia.

That a publisher cannot reproduce an individual freelance contribution in a "new anthology" or "an entirely different magazine or other collective work" simply means (in the words of the statute) that the publisher cannot *remove* the contribution from the "particular collective work" in which it originally appeared. A freelance contribution to *National Geographic* magazine, for example, cannot be reproduced in *The New Yorker*, the Encyclopedia Britannica, or a collection of articles on a particular topic. Contrary to the Eleventh Circuit's conclusion, the passage does not remotely suggest that a publisher cannot include a "particular collective work" in its *entirety* in a new (and independently copyrightable) collective work. The creation of a new collective work (whether or not copyrightable or copyrighted in its own right) is simply not inconsistent with the preservation of the "particular collective work" in which an individual freelance contribution originally appeared. One collective work can form part of another, just as a Sunday magazine forms part of a Sunday newspaper. Thus, a publisher is free to reproduce a "particular collective work" or "any revision of that collective work" in new media (such as microfilm, microfiche, or CD-ROM), regardless of whether the resulting product is itself characterized as a "new" collective work through the addition of new, original elements.

Accordingly, the Eleventh Circuit erred by focusing on whether the CNG itself is a "new" collective work rather than focusing on whether the CNG exploits any individual freelance contribution outside the context of the original collective work. Because the Eleventh Circuit asked the wrong question, it reached the wrong answer. The Section 201(c) privilege

applies here because the CNG preserves intact the integrity of the original print versions of *National Geographic* magazine.[2]

The practical consequences of the Eleventh Circuit's error are enormous. On the most direct level, the decision makes it impossible for publishers to create archives of their collective works in CD-ROM format, because the inevitable addition of independently copyrightable material (such as a computer program) necessarily defeats the privilege. Because it is impossible as a practical matter for those publishers (like National Geographic) that have already created CD-ROM archives of their collective works to reach retroactive license agreements with all of their past freelance contributors, the only solution for such publishers is to withdraw their CD-ROM products from the market. Needless to say, the destruction of a valuable historical archive like the CNG, which has allowed countless persons easy, quick, and inexpensive access to collective works, harms not only National Geographic, but also unknown generations of individuals, students, and scholars.[3]

---

[2] The Eleventh Circuit also erred by rejecting petitioners' distinct argument that the use of respondents' January 1962 cover photograph in the introductory montage was permissible under the fair use and *de minimis* doctrines. *See* App. 13a-16a. That rejection was expressly based in part on the court's conclusion that the "moving covers" sequence was "an integral part of a larger, new collective work" outside the scope of Section 201(c). App. 14a. Accordingly, the court's erroneous interpretation of Section 201(c) necessarily infected its fair use and *de minimis* analysis as well, and review of the former issue warrants review of the latter.

[3] Indeed, the CNG is presently sold at retail for less than $100, and grants a user access to all back issues of *National Geographic* magazine (which, in paperbound form, take up an entire room) on thirty discs. The same collection on microfilm, in contrast, takes up 170 rolls of film, and currently sells for $37,000. And a set of 717 microfiche cards reproducing all issues of the magazine since 1978 currently sells for approximately $3,000. Not surprisingly, very few (if any) individuals buy microfilm or microfiche (or the expensive machines necessary to read them) for home use—in sharp contrast to CD-ROM, which is ideal for home use on a personal computer.

And the consequences of the Eleventh Circuit's error are by no means limited to the CD-ROM context. Rather, by holding Section 201(c) inapplicable whenever a collective work is reproduced in a medium that includes independently copyrightable elements, the court essentially rendered the privilege a dead letter for *all* purposes. If an exact, image-based reproduction of a collective work like the CNG violates freelancers' copyrights, then publishers are essentially precluded from reproducing their collective works in *any* new media. That result is especially perverse in an age of rapid technological development, which allows collective works to be stored, retrieved, and searched in new ways that make access to such works more broadly, easily, and inexpensively available to all. And that result, needless to say, undermines copyright's constitutional goal of "promot[ing] the Progress of Science and useful Arts." U.S. Const. art. II, § 8, cl. 8.

Accordingly, as in *Tasini*, this Court should grant *certiorari* to address this issue of such great legal and practical importance. At the very least, the Court should grant *certiorari*, vacate the decision below, and remand for the Eleventh Circuit to reconsider its decision in light of this Court's subsequent decision in *Tasini*.

II. THE ELEVENTH CIRCUIT ERRED BY HOLDING THAT AN APPLICANT FOR A COPYRIGHT REGISTRATION PERPETRATES A "FRAUD" ON THE COPYRIGHT OFFICE WHEN THE APPLICANT DISCLOSES ALL THE INFORMATION THAT THE COPYRIGHT OFFICE REQUIRES.

The Eleventh Circuit separately erred by accusing National Geographic of having "perpetrated a fraud" on the Copyright Office when applying for the CNG's copyright registration. App. 12a n.13. This is not some arcane error of law, but a fundamental "depart[ure] from the accepted and usual course of judicial proceedings," S. Ct. R. 10(a): the accusation is of the utmost gravity, and manifestly erroneous. This Court

should not allow the lower courts to besmirch a litigant's reputation with impunity, especially a litigant like the National Geographic Society, a not-for-profit organization whose very existence depends in large measure on the continued support of its members and benefactors.

As noted above, the Eleventh Circuit concluded that the CNG was a "new" collective work based on the existence of the moving covers sequence and the computer program. App. 9a-13a. The court then noted that "[t]his analysis is totally consistent with the conduct of the Society when it registered its claim of copyright in the CNG," *id.* at 11a, because such registration necessarily presupposes the addition of some element of originality. The court then embarked on a frolic and detour through National Geographic's registration application, which it attached as an appendix to its published decision. In particular, the court focused on "section '6,' subpart 'b,' which requested, 'Material added to this work. Give a brief, general statement of the material that has been added to this work *and in which copyright is claimed.*" App. 12a (emphasis added). In response, the court noted, "the Society wrote 'Brief introductory audiovisual montage.'" *Id.*

Seizing on this answer, the court asserted that "the Society failed to indicate the third, and critical, element of the new work, the [computer] Program." *Id.* at 12a n.13; *see also id.* at 5a ("No reference was made to, nor was there any disclosure of, the copyrightable Mindscape Program or the two pre-existing, copyrightable sub-programs that it incorporates, all of which are also components of the CNG."). The court then accused the Society of having "perpetrated a fraud on the Copyright Office"—albeit, "[g]iving the Society the benefit of the doubt," perhaps "not . . . intentionally." *Id.* at 12a n.13. (A most curious accusation, given that fraud is an intentional tort. *See, e.g.*, 37 C.J.S. Fraud § 28 (1997).)

The Eleventh Circuit's accusation of "fraud on the Copyright Office" is manifestly erroneous. (One reason for this error may be that this issue was never briefed or argued by

any of the parties prior to the court's decision, and the court never solicited the views of the Copyright Office.) As explained by the very registration form that the Eleventh Circuit quoted and published, subpart 6(b) requires the applicant to list only "the material that has been added to this work *and in which copyright is claimed.*" App. 12a (emphasis added); *see also* Copyright Registration for Multimedia Works 4 (1999), available online at www.loc.gov/copyright/circs/circ55.pdf (instructing an applicant to fill out subpart 6(b) by "[b]riefly describ[ing] all the new copyrightable authorship *that is the basis of the present registration*") (emphasis added); *id.* at 2 (noting that "[a] separate registration is required . . . for any element of a multimedia kit that is . . . claimed by someone other than the copyright claimant for the other elements"). Because National Geographic did not claim a copyright in the computer program, it was neither necessary nor appropriate for National Geographic to refer to that program in that subpart.

Petitioners brought this error to the Eleventh Circuit's attention in their petition for rehearing and rehearing *en banc*. Several weeks later, while that petition remained pending, National Geographic received a detailed letter from the General Counsel of the Copyright Office confirming National Geographic's interpretation of the registration application. App. 27a-35a. The letter explains that the court's accusation of fraud on the Copyright Office is "based on a misunderstanding of copyright registration practices," and that "there can be no question of any attempt to perpetrate a fraud on the Copyright Office, and the court's speculation in footnote 13 of the opinion is inconsistent with the Copyright Office registration record for this particular work." App. 35a, 31a; *see also id.* at 27a ("[T]he court's remarks about the National Geographic Society's possible fraud on the Copyright Office appear to reveal a misunderstanding of Copyright Office registration practices."); *id.* at 28a ("[W]e find that the National Geographic Society's application complied with the Office's requirements for registration, and that there is no reason to

conclude that the application misled the Office in any way."); *id.* at 34a ("The National Geographic Society had no obligation to disclose or assert a copyright claim in the software.").[4]

National Geographic immediately forwarded the Copyright Office letter to the Eleventh Circuit. *Id.* at 25a-26a. Respondents, however, moved to strike the filing. Even before the expiration of petitioners' time to respond to the motion, the court granted the motion. *Id.* at 36a. Several weeks later, the court denied the pending petition for rehearing and rehearing *en banc* without deleting or otherwise modifying the accusation of fraud on the Copyright Office.

This Court should not allow the Eleventh Circuit's baseless accusation on a matter of such gravity to stand. It is bad enough that the court *sua sponte* accused National Geographic of having "perpetrated a fraud on the Copyright Office," App. 12a n.13, when the very registration application quoted by the court makes it perfectly clear that only material "in which copyright is claimed" need be set forth, *id.* at 12a. But it is another thing altogether for the court to refuse to correct such a manifest error once brought to its attention, especially where—as here—the court's analysis is disputed by the very federal agency against which the court deemed the "fraud" to have been perpetrated. Congress entrusted the complex responsibility of administering copyright registration procedures to the Copyright Office, not the Eleventh Circuit. Neither litigants nor federal agencies should be subject to such judicial caprice.

---

[4] Indeed, the Copyright Office explained that it is self-understood that "when works of authorship embodied in CD-ROM format are submitted for registration, computer programs may be included on the same CD-ROM, and that use of those computer programs may be necessary in order for a user to gain access to the work of authorship in which copyright is claimed." App. 32a. Accordingly, "it is not necessary in such cases that the application for copyright registration include a claim of copyright in the software." *Id.*

The Eleventh Circuit's holding merits this Court's review because the decision below is misleading, confusing, and leaves copyright registration applicants in the dark about what to disclose. Under the Eleventh Circuit's view, an applicant for a copyright registration in a multimedia work *must* include a copyrightable computer program in its application, even if the applicant makes no claim to the copyright; under the Copyright Office's view, the applicant *cannot* include such a program if the applicant does not claim the copyright. *See, e.g.,* Copyright Registration for Multimedia Works 2 ("A separate registration is required . . . for any element of a multimedia kit that is . . . claimed by someone other than the copyright claimant for the other elements."). Copyright registrants are thus faced with the Hobson's choice of following either the Copyright Office or the Eleventh Circuit in filling out a copyright registration application. In addition, the decision below subjects existing valid registrations in multimedia works to invalidation. If ever there were an issue calling for this Court's exercise of its "supervisory power" to correct a decision that has "so far departed from the accepted and usual course of judicial proceedings," S. Ct. R. 10(a), this is it.

CONCLUSION

For the foregoing reasons, this Court should grant the petition for writ of *certiorari.*

Respectfully submitted,

TERRENCE B. ADAMSON
ANGELO M. GRIMA
KAREN K. SCHWARTZ
NATIONAL GEOGRAPHIC SOCIETY
1145 Seventeenth Street, N.W.
Washington, D.C. 20036

KENNETH W. STARR
Counsel of Record
CHRISTOPHER LANDAU
KIRKLAND & ELLIS
655 Fifteenth Street, N.W.
Washington, D.C. 20005
(202) 879-5000

ROBERT G. SUGARMAN
NAOMI JANE GRAY
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153

July 30, 2001